Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 15448-0502

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On June 1, 2007 Signature _Tracy Reynolds_ Typed or printed name Tracy Reynolds	Application Number 09/854,306	Filed May 11, 2001
	First Named Inventor Eric Yang	
	Art Unit 3629	Examiner Janice Mooneyham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.
YES

The review is requested for the reason(s) stated on the attached sheet(s).
   Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
   See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
   (Form PTO/SB/96)

☒ attorney or agent of record.
   Registration number 50,266

☐ attorney or agent acting under 37 CFR 1.34.
   Registration number if acting under 37 CFR 1.34

_____
Signature

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Typed or printed name

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Telephone number

June 1, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

REMARKS

As will be seen from the discussion below, the rejections of all of the pending claims are predicated upon clear errors of fact and, consequently, should be reversed.

The Final Office Action rejected Claim 1 under 35 U.S.C. § 102(e) as being anticipated, allegedly, by Ginter. Claim 1 recites, among other features, that a licensing host "communicates with said first set of software over said network." This first set of software must be, according to Claim 1, the same set of software that a client's licensing inquiry regards (Claim 1 says, in part, "receiving . . . a first inquiry **regarding licensing of a first set of software under a particular contract**"). The most recent Office Action alleges that Ginter's VDE content creator 102 and/or VDE rights distributor 104 are analogous to the "licensing host" of Claim 1. Therefore, if Ginter's VDE content creator 102 and/or VDE rights distributor 104 does not communicate, over a network, with a set of software that a client's licensing inquiry regards under a particular contract, then Ginter does not disclose a licensing host that "communicates with **said** first set of software over said network" as recited in Claim 1.

In the Advisory Action mailed on April 24, 2007, the Examiner admits that, in Ginter's approach, "**no system communicates** with the content." The Examiner concedes that "one does not communicate with content." However, Claim 1 **requires** that the licensing host "communicates with said first set of software," where the "set of software" is **required** to be the set of software that the client's licensing inquiry regards. In Ginter, the only thing to which the alleged "inquiry regarding licensing under a particular contract" could possibly pertain is the VDE-protected content in the VDE content container. Yet, the Examiner admits that no system (ergo, no "licensing host")

communicates with this VDE-protected content.

In the Advisory Action, the Examiner argues that "one does communicate with the content creator or user or with the clearing house." Yet, even if this is so, it does not satisfy the requirements of Claim 1, because none of these entities (the content creator, the user, or the clearing house) is even a **set of software**, let alone a set of software that a client's licensing inquiry regards under a particular contract. Futhermore, no inquiry is ever received from any client regarding the licensing of any of these entities (the content creator, the user, or the clearing house) under any contract.

Because none of Ginter's systems communicates with any set of software that a client's licensing inquiry regards (as admitted by the Examiner in the Advisory Action), Ginter **cannot** disclose, teach, or suggest the method of Claim 1. Ginter does **not** disclose, teach, or suggest a licensing host that "communicates with said first set of software over said network," where "said first set of software" is a set of software that a client's licensing inquiry regards under a particular contract, as recited in Claim 1.

Thus, the rejection of Claim 1 is predicated upon clear errors of fact. Therefore, the rejection of Claim 1 under 35 U.S.C. § 102(e) should be reversed.

Similar to a step recited in Claim 1, Claim 23 recites, "sending license parameters from said management system over said network to **a licensing host that** (a) is coupled to said management system via said network, (b) **communicates with said first set of software over said network**, and (c) enforces said license parameters relative to said first set of software;" and Claim 56 recites, "sending license parameters from said management system over said network to **a licensing host that** (a) is embodied in a machine that is connected, via said network, to a machine in which said management

system is embodied, (b) **communicates with said first set of software over said network**, and (c) enforces said license parameters relative to said first set of software."

As is discussed above in relation to Claim 1, Ginter does not disclose that a licensing host **communicates**, over a network, **with a set of software** whose licensing the recited "inquiry" regards. Therefore, Ginter fails to disclose at least these aspects of Claims 23 and 56. Thus, the rejections of Claim 23 and 56 are predicated upon clear errors of fact. Therefore, the rejections of Claim 23 and 56 under 35 U.S.C. § 102(e) should be reversed.

By virtue of their dependence from Claim 1, Claims 2-17, 19, and 22 inherit the features that are distinguished from Ginter above. By virtue of their dependence from Claim 23, Claims 24-49, 51, and 55 inherit the features that are distinguished from Ginter above. By virtue of their dependence from Claim 56, Claims 57-64 inherit the features that are distinguished from Ginter above.

Claims 72-88, 90, 93-120, 122, and 126-135 recite computer-readable media bearing instructions for performing the methods of Claims 1-17, 19, 22-49, 51, and 55-64, respectively.

Claims 18, 20-21, 50, 52-54, 65-71, 89, 91-92, 121, 123-125 and 136-142 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Ginter.

Similar to a step recited in Claim 1, Claim 65 recites, "sending license parameters from said management system over said network to **a licensing host that** (a) is embodied in a machine that is connected, via said network, to a machine in which said management system is embodied, (b) **communicates with said set of software** over said network, and (c) enforces said license parameters relative to said set of software."

As is discussed above in relation to Claim 1, Ginter does not disclose that a licensing host **communicates**, over a network, **with a set of software** whose licensing the recited "request" regards. Thus, the rejection of Claim 65 is predicated upon clear errors of fact. Therefore, the rejection of Claim 65 under 35 U.S.C. § 103(a) should be reversed.

Claim 136 recites a computer-readable medium bearing instructions for performing the method of Claim 65. The remaining dependent claims depend from at least one of the independent claims discussed above. By virtue of their dependence, these claims inherit the features that are distinguished from Ginter above.

In summary, the rejections of all of the pending claims should be reversed, because, as shown above, the rejections of all of the pending claims are predicated upon clear errors of fact.